UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,246	04/30/2001	Yves Louis Gabriel Audebert	741.01101	8917

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EXAMINER
LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/844,246	AUDEBERT ET AL.
Office Action Summary	Examiner	Art Unit	
	Benjamin E Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 February 2005_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-7,9,10 and 15-42_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-7,9,10 and 15-42_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _31 July 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
   1.☐ Certified copies of the priority documents have been received.
   2.☐ Certified copies of the priority documents have been received in Application No. _____.
   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date 11/23/04
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment filed 28 February 2005 amends claims 1-3, 9, 10, 15-20, 29,

cancels claims 8, 11-14, and adds claim 42. Applicant's amendment has been fully considered

and is entered.

Response to Arguments

2.   Applicant's arguments, filed 28 February 2005, with respect to the rejection(s)of claim(s)

1-41 have been fully considered and are persuasive. Therefore, the rejection has been

withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view

of Chan, U.S. Patent No. 6,005,942.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-7, 9, 10, 15, 20-37 are rejected under 35 U.S.C. 102(b) as being anticipated by

Chan, U.S. Patent No. 6,005,942. Referring to claims 1, 4-6, 20-23, 25-36, Chan discloses a

method for downloading applications to a smart card after is has been issued wherein a smart

card issuer can electronically forward an application to a smart card, that is being interface at a

user terminal, over an appropriate network (Col. 10, lines 43-49), which meets the limitation of

establishing a remote communications pipe between a PSD and a remote computer system over a

network comprising a local client for use as a host to said PSD, wherein said local client

comprises means for functionally connecting to a PSD Interface and said network, and means for

functionally communicating over said network with said remote computer system. The

applications that can be forwarded can include any application that can be supported by a smart

card and include command interfaces, such as APDU interfaces which facilitate communication

with the external environment (Col. 5, lines 22-28), which meets the limitation of client

communication means for transmitting and receiving message packets over said network using a

packet based communications protocol, and for transmitting and receiving APDUs through said

PSD Interface. APDU interface can be used during past issuance installation of an application or

during loading card global data. An application load and install option is performed via a set of

appropriate APDU commands received by card domain (Col. 5, line 66 – Col. 6, line 3), which

meets the limitation of first client data processing means for receiving incoming message packets

from said remote computer system using said client communications means, separating

encapsulated APDUs from said incoming message packets thus generating desencapsulated

APDUs and routing said desencapsulated APDUs to said PSD through said PSD Interface. The

smart card executes and responds to commands from the issuer that result in a transition in the

card life cycle from one state to the next (Col. 12, lines 46-50), which meets the limitation of

second client data processing means for receiving incoming APDUs from said PSD interface,

encapsulating said incoming APDUs into outgoing message packets and routing said outgoing

message packets to said remote computer system through said client communications means.

Referring to claim 2, Chan discloses that the smart card is being interface at a user

terminal (Col. 10, lines 43-49), which meets the limitation of at least one PSD comprising means

for functionally connecting to said PSD Interface and means for functionally communicating

through said Interface. The applications that can be forwarded can include any application that

can be supported by a smart card and include command interfaces, such as APDU interfaces

which facilitate communication with the external environment (Col. 5, lines 22-28), which meets

the limitation of PSD communications means for transmitting and receiving APDU messages

through said PSD Interface. The smart card executes and responds to commands from the issuer

that result in a transition in the card life cycle from one state to the next (Col. 12, lines 46-50),

which meets the limitation of PSD processing means for interpreting said APDU messages,

executing commands included in said APDU messages and transmitting responses in APDU

format through said PSD Interface using said communications means. The smart card contains a

memory that stores a card identification number (Col. 2, lines 1-7), which meets the limitation of

memory storage means for storing at least one unique identifier.

Referring to claims 3, 20, Chan discloses a method for downloading applications to a

smart card after is has been issued wherein a smart card issuer can electronically forward an

application to a smart card, that is being interface at a user terminal, over an appropriate network

(Col. 10, lines 43-49), which meets the limitation of at least one remote computer system

comprising means for functionally connecting to said network and means for functionally

communicating with said local client, server communications means for transmitting and

receiving messages over said network using said packet based communications protocol. The

application server receives requests from the smart cards for applications and authenticates the

smart cards. Once authenticated, the application server passes the application data to the issuer

where it is transferred to the user terminal that is interfaced with the requesting smart card (Col.

22, lines 17-54), which meets the limitation of first server data processing means for receiving

requests from at least one applications level program, translating said requests into APDU format

and transmitting said APDU formatted requests to a second server data processing means, second

server data processing means for encapsulating said APDUs formatted requests received from

said first server data processing means into outgoing message packets and transmitting said

outgoing message packets over said network to said local client using said server

communications means. The applications that can be forwarded can include any application that

can be supported by a smart card and include command interfaces, such as APDU interfaces

which facilitate communication with the external environment (Col. 5, lines 22-28), which meet

the limitation of third server data processing means for receiving incoming messages from said

local client using said server communications means and separating encapsulated APDUs from

said incoming message packets thus generating desencapsulated APDUs and routing said

desencapsulated APDUs to a fourth server data processing means. An application load and install

option is performed via a set of appropriate APDU commands received by card domain (Col. 5,

line 66 – Col. 6, line 3), which meets the limitation of a fourth server data processing means for

receiving and translating said desencapsulated APDUs sent by said third server data processing

means into another message format thus generating a translated message and transmitting said

translated message to at least one applications level program.

Referring to claims 7, 24, Chan discloses that the applications can be encrypted and

subsequently decrypted before installation at the user terminal using a security processor on the

smart card (Col. 7, lines 52-62), which meets the limitation of a secure communications channel.

Referring to claims 9, 29, Chan discloses that the applications can be encrypted and

subsequently decrypted before installation at the user terminal using a security processor on the

smart card (Col. 7, lines 52-62), which meets the limitation of PSD communications means for

transmitting and receiving encrypted APDU messages through said PSD Interface, first PSD

processing means for decrypting incoming encrypted APDU messages using stored

cryptographic information, thus generating incoming decrypted APDU messages, second PSD

processing means for interpreting said incoming decrypted APDU messages, and executing

commands included in said incoming decrypted APDU messages. The security processor also

provides means for the smart card to encrypt communications (Col. 8, lines 5-27), which meets

the limitation of a third PSD processing means for encrypting outgoing APDU response

messages using stored cryptographic information thus generating outgoing encrypted APDU

response messages, and transmitting said outgoing encrypted APDU response messages in said

APDU format through said PSD Interface using said communications means. The smart card

contains a memory that stores a card identification number and cryptographic keys (Col. 2, lines

1-11), which meets the limitation of memory storage means for storing at least one unique

identifier and at least one cryptographic key.

Referring to claims 10, 29, Chan discloses a method for downloading applications to a

smart card after is has been issued wherein a smart card issuer can electronically forward an

application to a smart card, that is being interface at a user terminal, over an appropriate network

(Col. 10, lines 43-49), which meets the limitation of server communications means for

transmitting and receiving messages over said network using said packet based communications

protocol. The applications can be encrypted and subsequently decrypted before installation at the

user terminal using a security processor on the smart card (Col. 7, lines 52-62), which meets the

limitation of cryptography data processing means, cryptography data processing means

comprises means for encrypting said APDU formatted requests received from said first server

data processing means and sending said encrypted APDU formatted requests to said second

server data processing means and for decrypting said desencapsulated APDUs received from said

third server data processing means and sending said decrypted desencapsulated APDUs to said

fourth server data processing means. Once authenticated, the application server passes the

application data to the issuer where it is transferred to the user terminal that is interfaced with the

requesting smart card (Col. 22, lines 17-54), which meets the limitation of first server data

processing means for receiving requests from at least one applications level program, translating

said requests into APDU format and transmitting said APDU formatted requests to said

cryptographic data processing means, second server data processing means for encapsulating

encrypted APDUs formatted requests received from said cryptographic data processing means

into outgoing message packets and transmitting said outgoing message packets over said network

using said server communications means. The applications that can be forwarded can include any

application that can be supported by a smart card and include command interfaces, such as

APDU interfaces which facilitate communication with the external environment (Col. 5, lines

22-28), which meet the limitation of third server data processing means for receiving incoming

messages packets using said server communications means and separating encapsulated APDUs

from said incoming message packets thus generating desencapsulated APDUs and routing said

desencapsulated APDUs to said cryptographic data processing means. An application load and

install option is performed via a set of appropriate APDU commands received by card domain

(Col. 5, line 66 – Col. 6, line 3), which meets the limitation of a fourth server data processing

means for receiving and translating decrypted desencapsulated APDUs sent by said cryptography

processing means into another message format thus generating a translated message and

transmitting said translated message to at least one applications level program.

Referring to claims 15, 37, Chan discloses that the network can be an ATM network (Col.

10, lines 21-23), which meets the limitation of a hardwired network.

Referring to claim 42, Chan discloses a method for downloading applications to a smart

card after is has been issued wherein a smart card issuer can electronically forward an

application to a smart card, that is being interface at a user terminal, over an appropriate network

(Col. 10, lines 43-49), which meets the limitation of establishing a remote communications pipe

between a PSD and a remote computer system over a network using a local client as a host to

said PSD, wherein said local client is in functional connection with a PSD interface, and wherein

said local client and said remote computer system are in functional communications using a

packet based communications protocol over said network, the local client transmitting and

receiving message packets respectively to and from said remote computer system over said

network using a packet based communications protocol. The applications that can be forwarded

can include any application that can be supported by a smart card and include command

interfaces, such as APDU interfaces which facilitate communication with the external

environment (Col. 5, lines 22-28), which meets the limitation of the local client receiving

incoming message packets from said remote computer system, separating encapsulated APDUs

from said incoming message packets thus generating desencapsulated APDUs routing said

desencapsulated APDUs to said PSD through said PSD Interface. The smart card executes and

responds to commands from the issuer that result in a transition in the card life cycle from one

state to the next (Col. 12, lines 46-50), which meets the limitation of local client receiving

incoming APDUs from said PSD interface, encapsulating said incoming APDUs into outgoing

message packets and routing said outgoing message packets to said remote computer systems.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

        1.   Determining the scope and contents of the prior art.
        2.   Ascertaining the differences between the prior art and the claims at issue.
        3.   Resolving the level of ordinary skill in the pertinent art.
        4.   Considering objective evidence present in the application indicating obviousness
                or nonobviousness.

7.   Claims 16, 17, 19, 38, 39, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Chan, U.S. Patent No. 6,005,942, in view of Davis, U.S. Patent No. 6,105,008. Referring to

claims 16, 17, 19, 38, 39, 41, Chan does not disclose the network being a digital cellular

network. Davis discloses a smart card loading system of a cellular network (Col. 8, lines 18-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to implement the smart card updating system of Chan in a cellular network in order to update cell

phone smart cards.

8.   Claims 18, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan, U.S.

Patent No. 6,005,942, in view of Brown, U.S. Patent No. 5,455,863. Referring to claims 18, 40,

Chan does not disclose that the network can be optical. Brown discloses a network authentication

system wherein the network is wireline, optical fiber link, satellite, or any other type of

communication channel (Col. 8, lines 56-58). It would have been obvious to one of ordinary skill

in the art at the time the invention was made for the network of Chan to be optical because

Brown discloses that those skilled in the art would understand that different networks can be

used without departing from the spirit and scope of the invention (Col. 8, lines 48-55).
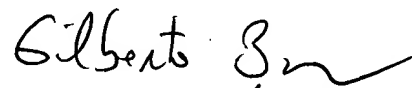
Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805.

The examiner can normally be reached on M-Th0 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin E. Lanier

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